

Remarks

The non-final Office Action dated June 11, 2009 lists the following rejections: claims 1,3, 12, 17, 19, 26-27 and 29 stand rejected under 35 U.S.C. § 102(e) over Griffith (U.S. Patent No. 6,842,647); claims 4 and 22 stand rejected under U.S.C. § 103(a) over the '647 reference in view of Engebretson (U.S. Patent No. 5,475,759); claims 5-11, 18 and 23-25 stand rejected under U.S.C. § 103(a) over the '647 reference in view of Shennib (U.S. Patent No. 7,016,504). Applicant appreciates that claims 2, 13-16 20-21 and 30 would be allowable if rewritten. In the discussion set forth below, Applicant does not acquiesce to any rejection or averment in the instant Office Action unless Applicant expressly indicates otherwise.

Applicant respectfully traverses the § 102(b) and § 103(a) rejections because the cited '647 reference either alone or in combination lacks correspondence to the claimed invention. For example, none of the asserted references teaches the claimed invention "as a whole" (§ 103(a)), *e.g.*, including aspects regarding receiving multiple identification signals and distinguishing an audio source based on its identification signal being different than the identification signal(s) included in other output audio signals. The Office Action appears to acknowledge, in connection with the notice of allowable subject matter, that these references do not teach such subject matter. Because no reference teaches these aspects, no reasonable interpretation of the asserted prior art, taken alone or in combination, can provide correspondence. As such, the rejections should be removed and all the claims deemed allowed.

New claim 32 should align with this same subject matter (deemed/deemable as being allowable).

Applicant further traverses the § 103 rejections because the cited references teach away from the Office Action's proposed combination. Consistent with the recent Supreme Court decision, M.P.E.P. § 2143.01 explains the long-standing principle that a § 103 rejection cannot be maintained when the asserted modification undermines either the operation or the purpose of the main '647 reference - the rationale being that the prior art teaches away from such a modification. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007) ("[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-

obvious for its intended purpose.”). In connection with the rationale asserted and using the rejection of claim 4 as an example, Applicant submits that the combination would render the embodiment (Fig. 3 of ‘647) inoperable for its intended purpose because the (PRM-) signal would attempt to control the hearing aid (in place of the elements 40, 48 and 50 in Fig. 3 of ‘647 unsuccessfully). Moreover, the Office Action errs by failing to provide a rationale for why a skilled artisan would be led to make this asserted modification. Under M.P.E.P. § 2143.01, the rejections cannot be maintained.

Applicant respectfully maintains that the § 103(a) rejections of various dependent claims are improper for various other reasons, as is discussed in detail below.

Regarding claims 5-9 and 23-25, the ‘647 reference further fails to correspond to aspects of the claimed invention directed to determining the distance between the acoustic source and the remote control device. The cited portions of the ‘647 reference simply discuss the distance over which the implantable system 10 and the remote control unit 30 can communicate with each other (*e.g.*, up to 45-60 cm); however, there is no mention of determining what the actual distance is between the implantable system 10 and the remote control unit 30 based on the signals sent between the devices. *See, e.g.*, Col. 5:48-60 and Col. 6:20-24. Accordingly, the rejections of claims 5-9 and 23-25 are improper and Applicant requests that they be withdrawn.

Regarding claims 10-11 and 24, the ‘647 reference further fails to correspond to aspects of the claimed invention directed to controlling the volume of the output audio signal responsive to a change in the distance between the acoustic source and the remote control device. As noted above, the ‘647 reference does not teach or suggest determining what the distance is between the implantable system 10 and the remote control unit 30. Moreover, the ‘647 reference also does not teach controlling the volume of the signal output by remote control unit 30 over signal path 32 in any manner, let alone controlling the volume responsive to a change in the distance between the implantable system 10 and the remote control unit 30. Accordingly, the rejections of claims 10-11 and 24 are improper and Applicant requests that they be withdrawn.

Regarding claim 18 (if not also other dependent claims), the Examiner improperly relies upon Official Notice with regards to “design choice” without providing documentary evidence to support the various conclusions upon which the rejections are based. *See, e.g.*,

M.P.E.P. § 2144.03. Consistent with M.P.E.P. § 2144.03, Applicant respectfully requests evidence in support of the proposition that such teaching is well known in the prior art and that there is adequate evidence of motivation to combine this prior art with the main reference. Thus, Applicant again requests that the Examiner provide documentary evidence to support the conclusions. These arguments have not been properly addressed as required in M.P.E.P. § 707.07(f). The § 103(a) rejection of claims 11, 13-16, 18 and 25 must be withdrawn

Applicant submits that further discussion regarding the impropriety of this rejection is unnecessary at this time in view of the clear lack of correspondence between the '647 reference and the claimed invention as discussed above.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9063.

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